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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,882	10/30/2003	Harumi Morino	58799-100	7806

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McDermott, Will & Emery  
600, 13th Street, N.W.  
Washington, DC 20005-3096

EXAMINER
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SCHMIDT, KARI L

ART UNIT	PAPER NUMBER
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2112

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/695,882

**Applicant(s)**

MORINO ET AL.

**Examiner**

Kari L. Schmidt

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 30 October 2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: referencing (20) in Figure 1 but it should be referencing (23) (page 2, 1<sup>st</sup> paragraph in amended specification), "S014" should be "S104" referring to Figure 7 (page 26, 1<sup>st</sup> paragraph), referencing to "step 501", should be "step S501" (page 38, 1<sup>st</sup> paragraph), and referencing to "step 601" should be "S601" (page 39, 1<sup>st</sup> paragraph). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "second use condition", "return unit" and "setting unit".

### ***Claim Objections***

Claim 12 is objected to because of the following informalities: there is a period located after "by". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said content" which doesn't appear anywhere in the Claim 1 section. There is insufficient antecedent basis for this limitation in the claim.

Claims 2-17 recites the limitation "said content" which appears as "decrypting encrypted content" in the Claim 2 section. There is insufficient antecedent basis for this limitation in the claims.

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Inoue et al. (US-2003/0005135).

Claim 1

Inoue discloses a license management system comprising:  
a license server connected to a network; and (Fig. 22: (2210) “right management server”)  
a terminal connected to the network; (Fig. 22: (150) “terminal”)  
wherein said server includes:  
a memory unit for storing a first license which includes a first use condition of said content; (Fig. 22: (2215) “user information management unit”)  
an issuance unit for, according to a request from said terminal (page 19, paragraph [0159] “the license ticket generation unit receives, from the terminal for which a plurality of users are registered, the license ticket issuance request in which the owner of the right information..), issuing a second license which includes a content key for decrypting encrypted content and a second use condition set such that value of said second use

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condition is within a value of said first use condition of said content; (page 19, paragraph [0159] “with the authentication information (“content distribution server”), it generates the license ticket based on the right information of the user identified with authentication information for the terminal, the license ticket generation unit issues the license ticket with the temporary usage restriction registered in the temporary restriction database being appended to, in response to the license ticket issuance request from the temporary user registered in the temporary usage restriction database; temporary license = second license”) and

a transmission unit for transmitting to said terminal said second license that is issued (Fig. 22: (132) “distribution unit” distribute the second license to the terminal); and

said terminal including (Fig. 22: (150) “terminal”):

a license control unit for managing said second license transmitted from said server (Fig. 23: (2300) “temporary usage restriction”); and

a reproduction unit for reproducing said encrypted content by use of said content key included in said second license (Fig. 22: (156) “content reproduction unit”); and

wherein said server further includes:

another memory unit for storing information on said second license (Fig. 22: (2214)); and

a return unit for checking said second use condition to automatically return said second license (Fig. 22: (2218));.

## Claim 2

Inoue discloses a server for issuing a content key for decrypting encrypted content, comprising:

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a memory unit for storing a first license which includes said content key and a first use condition of said content (Fig. 22: (2215) "user information management unit"); an issuance unit for, when a value of a second use condition of said content requested by a terminal does not exceed a value of said first use condition stored in said memory unit, issuing a second license which includes said content key and said second use condition; and a communication unit for transmitting said second license to said terminal (Fig. 22: (2214)).

### Claim 3

Inoue discloses the server as claimed in claim 2, wherein:

said memory unit ("temporary usage restriction database") stores license information including said second use condition; and

said server further comprises a return unit for, when a value of an actual use condition of said content at said terminal has exceeded said value of said second use condition, returning said second license (Fig. 23, page 20, [0162] "expiration date for registering the temporary user in the terminal information in the terminal").

### Claim 4

Inoue discloses the server as claimed in claim 3, wherein: said first use condition includes the maximum allowable number of simultaneous issues indicating the number of issues of said second license which can be distributed at the same time; and said return unit stops return processing when the maximum allowable number of

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simultaneous issues has exceeded its initial value stored in said memory unit (page 18, [0155] “temporary usage restriction system is a content distribution system that permits registration of plurality of users on one terminal”).

#### Claim 5

Inoue discloses the server as claimed in claim 3, wherein:  
said license information includes return mode information indicating whether or not said second license is to be returned, said return mode information being provided for each second license; and said return unit executes or stops return processing on said second license according to said return mode information (Fig. 28 and page 21, paragraph [0169]).

#### Claim 6

Inoue discloses the server as claimed in claim 5, further comprising a setting unit for setting said return mode information according to a request from said terminal. (Fig. 32 and page 22, paragraph [0176] “the right information ID of the right information corresponding to the content selected on the license ticket issuance request screen, the authentication information and the terminal ID indicating the terminal on which the request is made are sent to the right management server” and page 21, paragraph [0171] “once the OK button is pressed, a command requesting the setting of more detailed content usage restriction is sent to the right management server”)



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Claim 7

Inoue discloses the server as claimed in claim 5, wherein said return mode information includes information for determining whether said server is to automatically return said second license. (page 21, paragraph [0172] "right management server that receives the command, the temporary usage restriction management unit reads out a temporary usage restriction template unit indicating the assumed choices of the temporary usage restrictions from the temporary usage restriction database..")

Claim 8

Inoue discloses the server as claimed in claim 5, wherein said return mode information includes information for determining whether said terminal is to return said second license to said server (Fig. 10 S1009 to S1010; page 20, paragraph [0163] " usage restriction returns the second license to terminal control information database also can be set for the temporary usage restriction where its deleted").

Claim 9

Inoue discloses the server as claimed in claim 8, wherein:  
said second use condition includes an expiration date/time of said content; and  
said return unit deletes said license information when said return mode information indicates that no return processing is to be performed and said expiration date/time of said content has passed (page 20, paragraph [0163]: "An expiration data for registering the temporary user in the terminal information in the terminal information

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database is described in the terminal registration expiration date. When the date expires the temporary user's ID registered in the terminal information in the terminal information database is deleted.").

#### Claim 10

Inoue discloses the server as claimed in claim 3, wherein said license information including said second use condition includes information about said second license (Fig 23, "the temporary usage restriction is stored correspondingly to the terminal ID, temporary user's ID, and the right owner user's ID and also terminal operation restriction and expiration date").

#### Claim 11

Inoue discloses the server as claimed in claim 10, further comprising a transmission unit for, when a request for restoring said second license has been received, transmitting said second license to said terminal to which said second license was transmitted, said second license storing said information about said second license (page 19, paragraph [0160] "the temporary usage restriction management unit searches the temporary usage restriction database using the terminal ID attached to the request, and decides whether the requesting exclusive terminal is registered in the temporary usage restriction database or not. If it is registered in the temporary usage restriction management unit, the temporary usage restriction management unit identifies the user based on the authentication information included in the request...").

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Claim 12

Inoue discloses the server as claimed in claim 2, wherein: said first use condition is determined by a manager of said content or a manager of said first license; and said second use condition is determined by a user of said content (Fig. 22 (2215): "user information management unit").

Claim 13

Inoue discloses the server as claimed in claim 3, wherein:  
said first use condition includes the maximum allowable number of simultaneous issues indicating the number of issues of said second license which can be distributed at the same time (page 18, [0155] "content distribution system that permits registration of plurality of users on one terminal." Fig. 23);  
said second use condition includes an expiration date/time of said content; when said issuance unit has issued said second license, said issuance unit decrements the maximum allowable number of simultaneous issues; and said return unit increments the maximum allowable number of simultaneous issues when said expiration date/time of said content has passed (page 4, paragraph [0059]: "subtracts the usage duration or usage number in this request from the read-out content rule so as to calculate the remaining usage duration or usage number and updates the right information using the calculation result and page 23, paragraph [0183] "the terminal operation restriction and the terminal registration expiration date are added to the parental control information or also known as temporary usage restriction database.").

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Claim 14

Inoue discloses the server as claimed in claim 3, wherein:

said second use condition includes an expiration date/time of said content;

when said issuance unit has issued said second license, said issuance unit inhibits further issuance of said second license; and when said expiration date/time of said content has passed, said return unit cancels said inhibition of further issuance of said second license (Fig. 22 (113): "content usage right database" = issuance unit; (2217) "license ticket generation unit" = expiration date/time of said content has passed and page 20, paragraph [0163]: "An expiration data for registering the temporary user in the terminal information in the terminal information database is described in the terminal registration expiration date. When the date expires the temporary user's ID registered in the terminal information in the terminal information database is deleted.").

Claim 15

Inoue discloses the server as claimed in claim 3, wherein:

said first use condition includes a first value of the number of reproduction operations of said content;

said second use condition includes a second value of the number of reproduction operations of said content;

when said issuance unit has issued said second license, said issuance unit subtracts said second value of the number of reproduction operations from said first value of the number of reproduction operations;

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upon receiving said second license returned from said terminal, said return unit adds the update of said second value of the number of reproduction operations included in said second use condition to said first value of the number of reproduction operations; and when an expiration date/time of said content has passed, said return unit maintains said first value of the number of reproduction operations from which said second value of the number of reproduction operations has been subtracted (Fig. 22: (156) and page 15, paragraph [0131]: “content reproduction unit: the license ticket processing unit 154 confirms at regular time intervals whether the content reproduction unit 156 continues reproducing the content or not (S1207), and if it continues, interprets the license ticket 2 again, and decides whether the reproduction of the content is permitted or not (S1202). When the reproduction of the content is permitted depending upon the reproduction condition at that time, as a result of the interpretation of the license ticket 2 (S1203), the license ticket processing unit 154 further interprets the license ticket 1 (S1204), and decides whether the reproduction of the content is permitted or not at that time (S1205)”, Fig. 23; page 20, [0162] “expiration date for registering the temporary user in the terminal information in the terminal” (page 4, paragraph [0059]: “subtracts the usage duration or usage number in this request from the read-out content rule so as to calculate the remaining usage duration or usage number and updates the right information using the calculation result and).

#### Claim 16

Inoue discloses a terminal capable of communicating with a server for issuing a content key for decrypting encrypted content, said server comprising: a first memory

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unit for storing a first license which includes said content key and a first use condition of said content (page 3, [0058] "temporary usage restriction database");

an issuance unit for, when a value of a second use condition of said content requested by said terminal does not exceed a value of said first use condition stored in said first memory unit, issuing a second license which includes said content key and said second use condition (page 19, paragraph [0159] "the license ticket generation unit receives, from the terminal for which a plurality of users are registered, the license ticket issuance request in which the owner of the right information.."); and

a communication unit for transmitting said second license to said terminal (Fig. 22, (119): "communication unit");

said terminal comprising (Fig. 22: (140 and 150));

a second memory unit for storing said encrypted content (Fig. 22 (155) "content storage unit")

a communication unit for receiving said second license from said server (Fig. 22, (152) "communication unit");

a decryption unit for decrypting said encrypted content in said second memory unit by use of said content key included in said second license (Fig. 22, (154): "license ticket processing unit"); and

a reproduction unit for reproducing said decrypted content according to said second use condition included in said second license (Fig. 22, (156) "content reproduction unit").

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Claim 17

Inoue discloses the terminal as claimed in claim 16, wherein said reproduction unit updates said second use condition each time said reproduction unit reproduces said content (Fig. 22, (156) "content reproduction unit").

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Namba et al. (US 2003/014009) teaches a license management system that distributes license information which makes it possible to use a content under a certain under a certain usage rule from a management device to a terminal device used by a user who requests a use of a content via a communication network. Higashi et al. (US 2002/0107806) teaches a content usage management system that includes a terminal device that uses content as a digital production, and a server device that manages usage of the content on the terminal device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kari L. Schmidt whose telephone number is 571-270-1385. The examiner can normally be reached on Monday -Friday: 7:30am - 5:00pm (with alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Griffin can be reached on 571-272-1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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KS

  
WALTER D. GRIFFIN  
SUPERVISORY PATENT EXAMINER